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In the Supreme Court of the United States

OCTOBER TERM, 1940

No. 823

JAX ICE & COLD STORAGE COMPANY, A CORPORATION, TRADING AS JAX BREWING COMPANY, PETITIONER

v.

CONWAY P. COE, UNITED STATES COMMISSIONER OF PATENTS, AND JACKSON BREWING COMPANY, A CORPORATION

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR RESPONDENT COMMISSIONER OF PATENTS IN OPPOSITION

OPINIONS BELOW

The orders of the District Court of the United States for the District of Columbia (R. 16–17) were entered without opinion. The *per curiam* opinion of the United States Court of Appeals for the District of Columbia (R. 21–22) is not yet reported.

JURISDICTION

The judgment of the United States Court of Appeals for the District of Columbia was entered on December 9, 1940 (R. 22). The petition for a writ of certiorari was filed on March 7, 1941. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

The Act of March 3, 1927, confers jurisdiction of suits for the cancellation of a trade mark registration upon the District Court of the United States for the District of Columbia in cases where there are "adverse parties residing in a plurality of districts not embraced within the same State." The question is whether the Commissioner of Patents is an "adverse party."

STATUTES INVOLVED

The pertinent statutes are set forth in the Appendix, *infra*, pp. 11–13.

STATEMENT

On May 21, 1937, and on June 8, 1937, petitioner filed applications in the United States Patent Office praying for the cancellations of two trade mark registrations issued in the name of respondent Jackson Brewing Company (R. 5), a Louisiana corporation (R. 2). Petitioner claimed that the brewing company had abandoned the trade marks by virtue of an agreement with petitioner

consenting to the latter's use of the trade marks in four named states (R. 5). On motion of the Jackson Brewing Company, the applications for cancellation were dismissed by the Examiner of Interferences, and on February 11, 1939, the dismissal was affirmed by the Commissioner of Patents (R. 6).

Thereupon, on August 3, 1939, petitioner brought this action for cancellation in the District Court of the United States for the District of Columbia, joining both the Jackson Brewing Company and the Commissioner of Patents as parties defendant (R. 1–7). The action was purportedly brought under Section 9 of the Trade-mark Act of 1905, c. 592, 33 Stat. 724 (15 U. S. C. Sec. 89) and Section 4915 of the Revised Statutes (35 U. S. C., Supp. V, Sec. 63), and the jurisdiction of the District Court was sought to be maintained under the Act of March 3, 1927, c. 364, 44 Stat. 1394, 35 U. S. C. Section 72 (a).

The Jackson Brewing Company moved to dismiss, on the ground that the District Court had no jurisdiction because the company was a Louisiana corporation and the Commissioner of Patents was not an "adverse party" within the meaning of Section 72 (a), with the result that "the named Defendants do not constitute 'adverse parties residing in a plurality of districts not embraced in the same State' " (R. 11). Thereafter, the Commissioner of Patents moved to dismiss (R. 12–13) on the grounds that he was not a proper party to

the action and that the action could not proceed against him in the absence of the Jackson Brewing Company, a necessary party.

Both motions to dismiss were granted (R. 16, 17). On appeal the court below affirmed, *per curiam* (R. 22).

ARGUMENT

The court below affirmed the judgment sustaining the motions to dismiss on the authority of its prior decisions in *J. C. Eno (U. S.) Limited* v. *Coe,* 106 F. (2d) 858 (App. D. C.) and *Coe* v. *Hobart Mfg. Co.,* 102 F. (2d) 270 (App. D. C.). In the *Eno* case, it held that the person to whom registration had been granted was a necessary party to an action for cancellation of a trade mark and that such an action could not, therefore, be maintained against the Commissioner of Patents alone. In the *Hobart* case (p. 271), it held that the "adverse parties" contemplated by the Act of March 3, 1927, c. 364, 44 Stat. 1394 (35 U. S. C. Sec. 72 (a)), which confers jurisdiction on the District Court of the United States for the District of Columbia "if it shall appear that there" are "adverse parties residing in a plurality of districts not embraced within the same State", are parties adverse to the plaintiff, that the Commissioner was not an "adverse" party in an action to establish priority of invention among private claimants, and that the private defendant must, therefore, be sued at its residence in accordance with the general venue provisions of Section 51 of the

Judicial Code. Petitioner does not deny that the Jackson Brewing Company is a necessary party to this proceeding, but contends that the Commissioner is an "adverse" party for purposes of Section 72 (a), and that the contrary ruling in the *Hobart* case is unsound and in conflict with decisions of other circuit courts of appeals and, indeed, with the prior decisions of the court below. Petitioner's contentions are without merit.

1. The term "adverse parties" as used in Section 72 (a) has reference only to private parties claiming an interest in a patent or trade mark adverse to the plaintiff and does not include the Commissioner of Patents. The occasion for the enactment of Section 72 (a) was that theretofore plural defendants who resided in different districts could not be sued under Section 4915 in any court, because they could not be served in any district. *Coe* v. *Hobart Mfg. Co., supra,* at 272; *Hazeltine Corporation* v. *White,* 68 F. (2d) 715, 717 (C. C. A. 2d).[1] This difficulty arose, and can arise, only where there are a plurality of private defendants and the reach of the statute was plainly intended to be limited accordingly.

Actions to determine priority or ownership have regularly been instituted against a single private defendant at the residence of the defendant with-

[1] The equitable remedy provided by Section 4915, which in terms applies to patent cases only, has been made applicable to trade mark cases by Section 9 of the Trade Mark Act of 1905. *Baldwin Co.* v. *Robertson*, 265 U. S. 168.

out joining the Commissioner. *Cleveland Trust Co.* v. *Berry,* 99 F. (2d) 517 (C. C. A. 6th); *Century Distilling Company* v. *Continental Distilling Company,* 106 F. (2d) 486 (C. C. A. 3d); see *Coe* v. *Hobart Mfg. Co., supra,* at 272. In such proceedings, the court observed *obiter* in the *Berry* case (*supra,* at 520), the Commissioner may be a "proper" party, although this question has never been squarely decided. It is clear, however, that he is not a "necessary" party, even though, under the decision in *Hill* v. *Wooster,* 132 U. S. 693, the question whether the invention is patentable or the trade-mark is entitled to registration may be presented. Cf. *Cleveland Trust Co.* v. *Berry, supra; Century Distilling Company* v. *Continental Distilling Company, supra; Coe* v. *Hobart Mfg. Co., supra.* As petitioner apparently concedes, under Revised Statutes, Section 4915, the Commissioner is not a necessary party and need not be served unless there is "no opposing party." Section 4915, evidently with reference to proceedings in which the Commissioner is not joined, empowers the court to "authorize" the Commissioner to grant (or cancel) a trade-mark or patent, and in practice the Commissioner has almost invariably acted in accordance with the judgment of the court.

2. The decision below is not in conflict with the decision of the Circuit Court of Appeals for the Sixth Circuit in *Cleveland Trust Co.* v. *Berry,*

supra, or with that of the Circuit Court of Appeals for the Third Circuit in *Drackett Co.* v. *Chamberlin Co.,* 81 F. (2d) 866. In the *Berry* case the court merely observed *obiter* that the Commissioner was a "proper party" in an action between private claimants under Revised Statutes, Section 4915, to determine priority. The question whether the Commissioner is an "adverse party" within the meaning of 35 U. S. C. Section 72 (a) was not and could not have been presented. And if, as the courts below held, the Commissioner is not an "adverse party" so that the District Court of the United States for the District of Columbia had no jurisdiction of this suit, it is here immaterial whether the Commissioner would be a proper party. Hence no conflict warranting certiorari would in any event arise from the fact that the Commissioner's motion to dismiss gave as one ground that the Commissioner was not a proper party.

The *Drackett* case is clearly distinguishable. In that case an application for registration of a trade-mark was opposed in the Patent Office by a private person claiming ownership of the trade-mark. The registration was denied by the Commissioner on the ground that the trade-mark was not entitled to registration. The court held that since the Commissioner had found that the trade-mark was not entitled to registration the conflicting claimant was not an "opposing party" within the meaning of Revised Statutes, Section 4915,

and that an action to compel registration must be brought against the Commissioner. No question was presented whether the action could have been maintained in the District of Columbia under 35 U. S. C. Section 72 (a). In *Century Distilling Company* v. *Continental Distilling Company,* 106 F. (2d) 486 (C. C. A. 3d), not cited by petitioner, the same court subsequently held that the Commissioner was not a necessary party where registration had been granted and an action was instituted under Section 4915 to determine priority or ownership as between private claimants.[2]

3. The decision of the court below is not in conflict with the decision of this court in *Baldwin Co.* v. *Robertson,* 265 U. S. 168. In that case

[2] The decision below is not inconsistent with the prior decisions of the Court of Appeals of the District of Columbia. In *Alexandrine* v. *Coe,* 71 F. (2d) 348, it was held that an action may be maintained under Revised Statutes, Section 4915, against the Commissioner alone to prevent cancellation of registration. In the *Eno* case the Court of Appeals, without determining whether the *Alexandrine* case had been correctly decided, distinguished the case upon the ground that the person to whom registration has been granted was certainly *a necessary party* regardless of whether the defeated applicant also must be joined. The petitioner does not contend that the Jackson Brewing Company is not a necessary party in this case. *Hygienic Products Co.* v. *Coe,* 85 F. (2d) 264, also cited by petitioner, merely held that a defeated applicant for a trade-mark application need not first appeal to the Court of Customs and Patent Appeals before resorting to a suit in equity under Section 4915. The question whether the Commissioner is an "adverse party" within the meaning of 35 U. S. C. Section 72 (a) was not raised or considered.

the court merely held that the provisions of Revised Statutes, Section 4915, which in terms apply only to patents, were made applicable to trade-marks by Section 9 of the Trade-mark Act of 1905. In the course of its opinion the court stated that a party whose application for cancellation of a trade-mark had been rejected by the Patent Office could resort to a suit in equity against the Commissioner under Section 4915. The question whether the Commissioner could be sued, however, or whether the Commissioner was a necessary party in an action against a private claimant where the application for cancellation had been rejected was not in issue and does not appear to have been given consideration. See *J. C. Eno (U. S.) Limited* v. *Coe, supra,* at 859. Moreover, the *Baldwin* case was decided before the enactment of 35 U. S. C. Section 72 (a), and it is clear that the court did not expressly or inferentially hold that the Commissioner was an "adverse party" within the meaning of that statute.

4. No question of importance is presented. Where there are only two opposing parties claiming an interest in a patent or trade-mark it has heretofore been the settled practice to determine the question of priority in an action instituted at the residence of one of the claimants. There is thus no reasonable doubt as to the procedure to be followed in such cases. And

the fact that the petitioner, having elected to follow a novel course of action, has lost any right to judicial review because of the expiration of the statutory period, obviously does not present a question of general interest.

CONCLUSION

For the foregoing reasons it is respectfully submitted that the petition should be denied.

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